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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,612	11/30/2001	Stephen Ewer	42579	6098

7590

04/06/2004

Tara L. Hoffman  
Roylance, Abrams, Berdo & Goodman, L.L.P.  
1300 19th Street, N.W., Suite 600  
Washington, DC 20036

EXAMINER

TUGBANG, ANTHONY D

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/996,612

Applicant(s)

EWER ET AL.

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-33 is/are pending in the application.
- 4a) Of the above claim(s) 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The applicants' amendment filed 1/22/04 (Paper No. 8) has been fully considered and made of record.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 24 is drawn to a process removing a section of cover, classified in class 29, subclass 876.
  - II. Claim 33 is drawn to snap fitting, classified in class 29, subclass 453.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions of Groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group II has separate utility such as snap fitting cover fittings. See MPEP § 806.05(d).
5. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.
6. Claim 22 link(s) the inventions of Groups I and II above. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 22.

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Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

7. Newly submitted Claim 33 is directed to an invention that is independent or distinct from the invention originally claimed for the reasons set forth above.

Since applicant has received an action on the merits for the originally presented invention (Group I), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claim 33 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 112***

8. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 32, the phrase of “single raceway” (line 2) is confusing and misleading rendering the claim as being vague and indefinite. The term of “single” can imply that there is only one raceway, which at least is contradictory to the recitation of “second and third raceways” (line 2).

***Claim Rejections - 35 USC § 102***

9. Claims 22, 23, 26-29, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Bowen et al 5,057,981.

Bowen discloses a method of connecting raceways comprising: joining respective ends of first and second raceways (left conduits 122 in Fig. 4) at first junction areas (end regions of conduits 122 joined at coupling 124) so that the ends of the first and second raceways engage and form a joint at the first junction area; coupling a first cover fitting (left coupling 124 in Fig. 4) over the first junction area so that a portion of the first cover fitting engages each end of the first and second raceways; joining ends of third and fourth raceways (right set of conduits 122 in Fig. 4) at a second junction (area occupied by right coupling 124) so that ends (one end at conduit 122 at coupling 150 and another end of the other conduit 122 at support 116) of the third and fourth raceways are spaced apart from one another at the second junction area with a curved base (any curved region along conduit 122) disposed therebetween; and coupling a second cover fitting (right coupling 124) over the second junction area so that a portion of the second cover fitting engages each respective end of the third and fourth raceways, which meets all of the limitations of the claimed invention. Bowen further suggests that either one of the couplings can be a miter joint to join any of the raceways (see col. 3, lines 10-12).

Regarding Claim 23, the shape of the raceways shown by Bowen (in Fig. 4) indicates that the first and second raceways and third and fourth raceways, are each substantially perpendicular to one another, respectively.

Regarding Claims 28 and 29, Bowen further teaches first and second support surfaces 116 with the curved base being mounted to either support surface between ends of the third and fourth raceways and placing multiple sets of wires 34 in each of the raceways.

Regarding Claim(s) 31, the first and second cover fittings (left and right couplings 124, respectively) of Bowen are considered to be substantially identical in shape.

Regarding Claim(s) 32 as best understood, the second and third raceways of Bowen form a single, integral raceway.

***Claim Rejections - 35 USC § 103***

10. Claims 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowen et al.

Bowen teaches the claimed connecting method as relied upon above.

Regarding Claim 25, the claimed “second cover fitting” can be alternatively read as the balloons 12 (in Fig. 1) which completely covers the curved base in another embodiment (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the one embodiment (Fig. 4) of Bowen by utilizing the balloons as a “second cover fitting”, as taught by another embodiment of Bowen (Fig. 1), to positively provide an alternative decorative pattern (see col. 2, lines 45-55).

Regarding Claim 30, it would have been an obvious matter of design choice to choose any desired radius of the curved base and maximum bend radius of the second set of wires, since the applicants have not disclosed that the claimed feature of having the “radius of the curved base defining a radius equal to or greater than the maximum bend radius of the second set of wires”, solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the radius of wires and radius of the curved base taught by Bowen. Moreover, the claimed “radius” of the second set of wires and curved base does not provide any manipulative difference when compared to the connecting process of Bowen et al.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowen et al in view of Willette 4,319,075.

Bowen discloses the claimed connecting method further including exposed end sections of each of the bases of the third and fourth raceways engaging portions of the second cover fitting (coupling 124). Bowen does not teach removing a section of a cover of each of the third and fourth raceways and exposing corresponding sections of the raceway base.

Willette teaches removing a section of a cover in each of at least two raceways (shown in Fig. 5) to expose corresponding end sections of each of the bases of the raceways to positively allow the rerouting of wires (see col. 1, lines 7-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Bowen by removing a section of a cover and exposing corresponding end sections of each of the bases of the third and fourth raceways, as taught by

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Willette, to positively allow the wires of the device of Bowen to be rerouted to additional devices.

*Response to Arguments*

12. Applicant's arguments filed 1/22/04 (Paper No. 8) have been fully considered but they are not persuasive.

In regards to the merits of Bowen et al, the applicants' assert that Bowen does not teach "joining...therebetween" (lines 8-10 of Claim 22) and "coupling...respectively" (lines 11-12 of Claim 22).

The examiner most respectfully disagrees. To further clarify the examiner's reading of Bowen, the examiner has attached Figure 4 herein of Bowen to illustrate many of the critical elements (i.e. third and fourth raceways) of with which the applicants' assert that Bowen is deficient.

The examiner notes that the term of "ends" (line 8 of Claim 22) is a very broad and relative limitation and does not preclude the number of ends that the "third" and "fourth" raceways each can have. In this case, the examiner has read the term "ends" as the third and fourth raceways having at least four ends. The "third raceway" having two ends with one end at the area occupied by element 150 and the other end occupied by element 124. The "fourth raceway" having two ends with one end at the area occupied by element 124 and the other end occupied by element 116. The claimed "second junction area" is read as the area occupied by element or coupling 124. Therefore, the ends of the third and fourth raceways at the second junction area (at 124) are joined together and also the ends of the third and fourth raceways (at



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150 and 116, respectively) are “spaced from one another” at the second junction area with a curved base (curved shape of third and fourth raceways) disposed between the ends of the third and fourth raceways (at 150 and 116, respectively). Furthermore, the second cover fitting (right coupling 124) is coupled over the second junction area such that the second cover fitting engages each end of the third and fourth raceways (at 124). The examiner’s position is that the “ends” (line 8 of Claim 22) can include the ends of the third and fourth raceways at elements 150 and 116, respectively and thus, maintains the rejection with Bowen. It appears that further limitations are needed with respect to the claimed “ends” of the third and fourth raceways in order to avoid Bowen.

With respect to Claim 30, the applicants further argue that the specifics of the radius (as recited in Claim 30) are to avoid damage to the wires. However, the examiner’s position is that Bowen would solve the same problem of avoiding damage to the wires to the extent that each of the raceways and wires of Bowen do have a bend radius. Other than “avoiding damage to the wires”, it is not clear how the relationship of the bend radius (as recited in claim 30) provides any manipulative difference over the claimed connecting process when compared to Bowen, since Bowen is attempting to solve the same problem.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

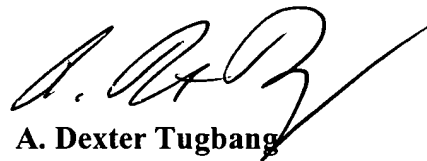
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**A. Dexter Tugbang**  
**Primary Examiner**  
**Art Unit 3729**

April 5, 2004